

REMARKS:

To begin with, the undersigned would like to take a moment to thank the Examiner for the well organized and detailed analysis concerning his view of the cited references. The undersigned understands that this analysis must have taken a fair amount of time, particularly given the fact that the primary reference includes 142 columns of text and 186 figures.

Nevertheless, reconsideration is respectfully requested of the rejection of claims 1, 2, 4 and 16-22 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,339,767 ("Rivette et al.").

More particularly, even assuming, *arguendo*, as the Examiner does, that Rivette et al. discloses a recursive patent citation function (i.e., for searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which is cited in at least one patent identified by the first generation data), it is respectfully submitted that Rivette et al. nowhere shows or even suggests the claimed step of operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test (as recited in independent claims 1 and 18).

In this regard, the undersigned would like to refer to the following text from Rivette et al. which is directed to Fig. 65 (which the Examiner has asserted "indicates the step of operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test"):

Referring again to step 8612 in FIG. 86, the patent citation report can be performed and displayed in a recursive fashion with an operator specified depth. The display of such a recursive patent citation function is shown in FIG. 65. In the example of FIG. 65, patent 1 is the source patent, and patents 2-4 are cited in patent 1 (that is, patents 2-4 are citing patents with respect to source patent 1). The patent citation report of FIG. 65 is multi-leveled. Accordingly, the display format of FIG. 65 indicates that patents 5-8 are cited in patent 2, patent 9 is cited in patent 3, and patents 10-12 are cited in patent 4. The example format 6502 shown in FIG. 65 is a two level patent citation report. The present invention can support patent citation reports of any operator specified level. Other

Page 3
U.S. Serial No.: 09/769,906

display formats could be used by the invention to more effectively display the results of multi-level patent citation reports, such as the well-known Xerox hyperbolic tree display format. (Col. 88, line 65 to Col. 89, line 14) (emphasis added)

As seen from the first underlined sentence above (as well as from Fig. 65 itself), the patent citation report simply presents all patents cited by a previous generation source patent.

In other words, while Rivette et al. may disclose a patent citation function which performs in an iterative or recursive manner to produce a multi-level citation report, the Rivette et al. disclosure simply does not show or suggest the additional step of identifying or filtering out a patent based upon that patent being cited in the patent under test (for example, if patent number 8 of Rivette et al.'s Fig. 65 is also cited by the patent under test (patent 1 in this case), Rivette et al. does not identify or filter out patent number 8 in any manner which distinguishes its treatment from patent numbers 2 through 12).

Moreover, the so-called "well-known Xerox hyperbolic tree display format" discussed in the second underlined sentence above appears to be just that, a display format (which in no manner shows or suggests the additional step of identifying or filtering out a patent based upon that patent being cited in the patent under test).

Of course, since claims 2, 4, 16 and 17 depend, directly or indirectly, from independent claim 1 and claims 19-22 depend, directly or indirectly, from independent claim 18, each of these dependent claims is submitted to be patentably distinct for at least the same reasons as the independent claim from which it depends

Therefore, it is respectfully submitted that the rejection of claims 1, 2, 4 and 16-22 under 35 U.S.C. §103(a) as allegedly being unpatentable over Rivette et al. has been overcome and that all of the pending claims are now in condition for allowance.

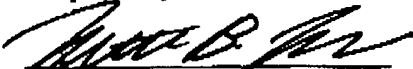
Finally, it is noted that an Information Disclosure Statement was filed in the present application via Express Mail on July 5, 2003 (along with the \$180 fee set forth in 37 C.F.R. §1.17(p)). This July 5,

Page 4
U.S. Serial No.: 09/769,906

2003 Information Disclosure Statement was thus filed before the above-mentioned September 24, 2003 Final Action. Accordingly, the undersigned respectfully requests that the Information Disclosure Statement be entered and that the Examiner initial the Form 1449 submitted therewith and provide a copy with the next communication (in accordance with M.P.E.P §609).

Favorable reconsideration is earnestly solicited.

Respectfully submitted,



Matthew B. Tropper
Registration No. 37,457
30 Southern Parkway
Plainview, NY 11803
(516) 576-1440

Dated: December 23, 2003